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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,984	12/22/2000	Leon Batachia	22097-003	4295

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY  
AND POPEO, P.C.  
ONE FINANCIAL CENTER  
BOSTON, MA 02111

EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,984

Applicant(s)

BATACHIA ET AL.

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-24 nad 44-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-24 nad 44-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Receipt of the amendment filed February 2, 2004 amending claims 1, 10, 15, 19 and 22, canceling claims 25-43 and adding claims 44-59. Claims 1-13, 15-24 and 44-59 are pending and are presented to be examined upon their merits.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-13, 15-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13, 15-24 and 44-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1, 19 and 44: in further consideration of the claims, what is the difference between "dynamically" generating an offer and normally generating an offer? Isn't it the same thing when in consideration that the offer is being electronically generated over the Internet and/or wireless devices?

Re claim 1: What are the metes and bounds of an "underutilized" product and/or service?

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the use of and/or is indefinite in the claim(s) because one of ordinary skill in the art at the time of the invention would not know whether limitation is being inclusive or exclusive.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 15, 19, 20, 44, 45, 46 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US 6,714,797) in view of Horstmann (US 6,285,985).

**Claims 1, 19 and 44:**

Rautila discloses transmitting digital information and/or a digital product to a mobile device (i.e., cell phone or PDA) from the Internet (see col. 2, ll. 56 to col. 3, ll. 38; and col. 4, ll. 32+).

Rautila fails to disclose generating an offer (advertisement) based on revenue management policy.

Horstmann discloses an offer and acceptance method comprising, dynamically generating an offer (advertisement) for a product or service based on revenue management policy (see Abstract), wherein the product or service is at least one of a perishable product or service and underutilized product or

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service and pushing the offer to a customer (see Horstmann, col. 3, ll. 26-40; and col. 4, ll. 27-40).

An artisan of ordinary skill in the art at the time of the invention of Rautila would have recognized the advantages and have been familiar with push technology in networks to send data or a program from a server to a client at the instigation of the server. Furthermore, an artisan would have been motivated to use the push technology as disclosed in Horstmann to interactively generate an offer (advertisement) to the customer as an alternative to user downloading digital data, to allow advertisers to inform customers of various of a products and services immediately as they become available. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

**Re claim 2, 20 and 45:**

Rautila in view of Horstmann discloses receiving a customer request, with means for a customer to request the offer (see Horstmann, "user initiated", fig. 6, col. 3, ll. 50+; col. 4, ll. 48+).

**Re claim 3 and 46:**

Horstmann discloses wherein generating the offer further comprises: using an intelligent agent to generate the offer (see Horstmann, col. 3, ll. 26-40).

and wherein the offer generating means further comprises: means for dynamically generating the offer (see Horstmann, col. 3, ll. 26-40).

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**Re claim 15 and 56:**

wherein dynamically generating the offer comprises: using environmental parameters (see Horstmann, col. 2, ll. 2-37).

3. Claims 4-13, 16-18, 20-22, 47-55 and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US 6,714,797) as modified by Horstmann (US 6,285,985) as applied to claim 1 as discussed above, and in further view of Walker et al ("Walker", 6138,105).

**Re claim 4 and 47:**

Rautila as modified by Horstmann discloses wherein generating the offer with a plurality of options, but fails to disclose an offer package.

Walker discloses a system, which provides an offer package via a network to a POS for a customer/consumer (see Walker, col. 2, ll. 47 to col. 3, ll. 9).

In view of Walker, it would have been obvious to an artisan at the time the invention was made to employ the features of Walker into Horstmann since the developer of Horstmann has the ability of customizing offers to the user, and thus to customize an offer package to the customer as an incentive for the customer to buy a particular features for more money would have been obvious. Therefore an artisan would have sought to provide different package offers, based upon the

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customer profile and thus have been within the ability of one of ordinary skill in the art.

**Re claim 5 and 48:**

Rautila as modified by Horstmann and in further view of Walker discloses wherein generating the plurality of options further comprises: generating the options based on customer profile (see Horstmann, col. 2, ll. 2-37).

**Re claim 6, 7, 49 and 50:**

Rautila as modified by Horstmann and in further view of Walker wherein generating the plurality of options further comprises: generating the options based on customer preferences (see Horstmann, Abstract, col. 2, ll. 2-37; col. 3, ll. 62 to col. 4, ll. 17).

**Re claim 8, 9, 51 and 52:**

Rautila as modified by Horstmann in further view of Walker wherein generating the plurality of options further comprises: generating the options based on a customer's perceived value (see Horstmann, Abstract, col. 2, ll. 2-37; col. 3, ll. 62 to col. 4, ll. 17).

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**Re claims 10 and 22:**

Rautila as modified by Horstmann wherein the generated offer is also based on the real-time location of the customer (see Rautila, Abstract).

**Re claims 11 and 53:**

Rautila as modified by Horstmann discloses wherein the policy is generated using heuristics (see Horstmann, Abstract, col. 2, ll. 2-37).

**Re claims 12 and 54:**

Rautila as modified by Horstmann discloses wherein the policy is generated using an expert system (see Horstmann, Abstract, col. 2, ll. 2-37).

**Re claim 13 and 55:**

Rautila as modified by Horstmann wherein the policy is expressed in business rules (see Horstmann, Abstract, col. 2, ll. 2-37).

**Re claim 16 and 57:**

Rautila as modified by Horstmann wherein generating a plurality of offer packages, each offer package directed to a target customer/customers (see Horstmann, col. 2, ll. 2-37).



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**Re claim 17 and 58:**

Rautila as modified by Horstmann discloses receiving a customer's selection; and updating a customer profile based on the selection (see Horstmann, col. 2, ll. 2-37).

**Re claim 18, 24 and 59:**

Rautila as modified by Horstmann discloses further comprising: a user interface to interact with customers (see Horstmann, col. 2, ll. 2-37).

**Re claim 21:**

Rautila as modified by Horstmann discloses further comprising means for generating the policy coupled to the offer generating means (see Horstmann, col. 2, ll. 2-37).

**Re claim 23:**

Rautila as modified by Horstmann discloses further comprising means to transmit the offer to the customer (see Abstract, Horstmann, col. 2, ll. 2-37).

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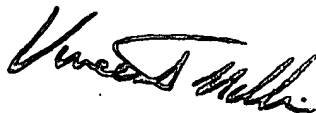
**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. \*\*\*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel S Felten  
Examiner  
Art Unit 3624



DSF  
April 7, 2004

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600